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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,597	02/05/2002	Paul A. Cronce	2401P	1789

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EXAMINER

BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/072,597

Applicant(s)

CRONCE, PAUL A.

Examiner

Bradley B. Bayat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date February 5, 2002.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

This communication is in response to application filed 5 February 2002. Claims 1-26 are presented for examination on the merits.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on February 5, 2002 is in compliance with the provisions of 37 CFR 1.97 and therefore considered by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Venkatesan et al. (hereinafter Venkatesan), US Patent 6,898,706 B1.

As per the following claims, Venkatesan discloses:

1. A method for the delivery of secure software license information to authorize use of a software product, the method comprising the steps of:

(a) associating with a software publisher a private and public key pair, wherein the software publisher provides the software product and includes a software program and an

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authorization program within the software product (fig 5, publisher 330 downloads file encrypted, including watermark keys and fingerprinted for client PC 520)

(b) associating a product private and public key with the software product, and including the product private key with the authorization program (fig 5, upon payment by user, publisher issues and downloads to user electronic license with usage rights including secret key 550);

(c) upon invocation of the software product on a computer, (i) generating by the authorization program a license request containing user and product information, (ii) digitally signing the license request with the product private key, and (iii) transferring the signed license request to a key authority (figure 3, certificate authority 307A signs with private key becoming part of the secure container for transfer to the key authority in figure 4)

(d) in response to the key authority receiving the signed license request, (i) generating a license using data extracted from the license request and license terms, (ii) signing the license with the publisher private key, and (iii) transmitting the signed license to the authorizing program (figure 13A, license verification, object decryption and enforcement 1300); and

(e) validating the signed license using the publisher public key, and using the license terms to control the use of the software product (figure 13A, enforcer process 1320, fig 13B instruct access in accordance with usage conditions 1380).

2. The method of claim 1 further including the step of providing the publisher public key as a certificate (fig 12, publisher's public key certificate 1220).

3. The method of claim 2 further including the step of providing the product public key as a

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certificate (fig 11, license generation and download 1122 including PID and certified public key).

4. The method of claim 1 further including the step of providing the license in a data exchange format (fig 5, client PC and Publisher data exchange 545 and 555).

5. The method of claim 4 further including the step of using XML as the data exchange format (column 11, lines 1-23, note that XML encoding may occur within HTML content; XML DTD describes a subset of HTML 4.0 for embedded use within other XML).

6. The method of claim 1 further including the step of using the license returned from the key authority to deliver additional key information to the computer (fig 13A, enforcer process 1320).

7. The method of claim 1 wherein step (d) further includes the step validating the license request using digital certificates (fig 11, computer ID of client PC 1122).

8. The method of claim 1 wherein step (e) further included the step of validating the license response using digital certificates (fig 11, computer ID of client PC 1122).

9. The method of claim 1 wherein step (e) further included the step of validating the license using the product information in the license, including product ID and publisher ID (figure 11, product Id and publisher 's symmetric encryption key 1122).

10. The method of claim 9 further including the step of transferring license terms to a separate security device for controlling the use of the software product (fig 5, encrypted store 610 includes license database 570 and object store 580).

11. The method of claim 1 wherein step (e) further included the step of preventing use of the software product on a different computer than that used to generate the license request by using a machine fingerprint embedded in the license (fig 5, fingerprint for client PCj 520).

Claims 12-15 are directed to a method as recited above and are rejected likewise.

16. A method for the delivery of secure software license information to authorize use of a software product, the method comprising the steps of:

(a) associating with the software product to be authorized an authorization program and a set of certificates, including a publisher certificate, a product certificate, wherein each certificate contains a public key and is associated with a private key of a public/private key pair (figure 12 and associated text);

(b) upon invocation of the software product on a computer, generating by the authorization program a formatted license request containing user and product information, signed using the private product key (fig 11, client license request 1110);

(c) transmitting the license request to a key authority in conjunction with a financial transaction (fig 11, request includes CID, client's public key, usage rights and payment information 1115);

(d) generating by the key authority a formatted license that includes license terms, and user and product information extracted from the license request, wherein the license is signed with the publisher private key associated with the publisher certificate (fig 11, upon authorization of payment generating license 1122);

(e) transmitting the signed license to the authorizing program (fig 11, transmit license to publisher's web server 1124); and

(f) validating by the authorization program the license using the publisher and certificate authority certificates and the user and product information contained within the license document, whereby the validation using the publisher and certificate authority certificates establish a trusted link back to the certificate authority (fig 13 A license verification, object decryption and enforcement 1300, 1320) and;

(g) using the license terms to control the use of the software product on the computer (fig 13B instruct use in accordance with rights and access 1380).

17. The method of claim 16 further including the step of formatting the license request and license documents using the proposed signed XML standard definition (column 11, lines 1-23, note that XML encoding may occur within HTML content; XML DTD describes a subset of HTML 4.0 for embedded use within other XML).

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18. The method of claim 16 further including the step of signing the product certificate using the publisher's private key, and signing the publisher certificate using the certificate authority's private key, thus establishing a trusted link from the product certificate back to the certificate authority (fig 15, 16 and associated text)

19. The method of claim 16 further including the step of signing the license request using the product private key, and including within the license request the product certificate (fig 11, step 1115).

20. The method of claim 16 further including the step of including financial transaction information within the license request (fig 11, step 1115)

21. The method of claim 20 further including the step of including financial transaction information within the license response (fig 11, step 1122).

22. The method of claim 16 wherein step (g) further includes the step of transferring the license terms to a separate security device for controlling the use of the software product (fig 11, step 1124 publisher's web server downloads license to EC 610).

23. The method of claim 16 wherein step (g) further includes the step of preventing use of the software product on a different computer than that used to generate the license request by using a machine fingerprint embedded in the license (fig 5, fingerprint 520).

Claims 24-26 are directed to a method as recited above and are rejected likewise.

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US Patent 6,611,812 B2 to Hurtado et al.
- US Patent 6,904,523 B2 to Bialick et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday-Friday 8am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Bradley Bayat', with a stylized flourish at the end.

Bradley Bayat
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Patent Examiner